REMARKS

Status of the Application

Claims 1-26 were pending in the present application.

Claims 1-26 are, now, cancelled.

New claims 27-34, added through the instant amendment, are now before the Examiner.

The Examiner rejects the claims on the following grounds:

1. Claims 1, 2, 5, 8 and 9 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 5, 8 and 9 of U.S. Patent No. 6,730,790;
2. Claim 3-4, 6-7 and 10-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3-4, 6-7; 10-26 of U.S. Patent No. 6,730,790; and
3. Claims 10, 16-18, 21 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

Applicants believe the preceding amendments and the following remarks traverse the Examiner's rejection of the claims. These remarks are presented in the same order as the rejections set out above.

1. Both Double Patenting Rejections Are Now Moot

In order to further business interest and without acquiescing to the rejections set out by the Examiner, while reserving the right to prosecute the same (or similar) claims as filed, the Applicants have cancelled claims 1-26 and have introduced a new claim set (e.g. claims 27-34). This new claim set is directed to methods for the inhibition of phosphodiesterases in the tissues

of a patient. Support for these claims is found in the specification of the application as filed on December 31, 2003. The Applicants specifically state that,

> "[w]ithout limiting the invention to any particular mechanism, *racemic monochloroflosequinan, the enantiomers of monochloroflosequinan, and the sulfone derivatives of monochloroflosequinan are enzyme inhibitors*. In specific examples, these compounds differentially inhibit various phosphodiesterases (e.g. PDE 1-6). The enzyme inhibition of racemic monochloroflosequinan, the enantiomers of monochloroflosequinan, and the sulfone derivatives of monochloroflosequinan has utility, for example, in therapeutics. Therefore, the present invention contemplates formulations and the *administration of formulations to patients*."[1] (emphasis added).

Moreover, the Applicants provide empirical data showing how specific compounds, described in the application as filed, selectively inhibit PDEs derived from specific tissues. For example, monochloroflosequinan sulfone[2] inhibits PDE3 while racemic monochloroflosequinan[3] inhbits PDE1, PDE2, and PDE3.

Given that none of the claims in U.S. Patent No. 6,730,790 are directed towards the use of racemic monochloroflosequinan, and its derivatives, in methods for the inhibition of PDEs in patients, the pending "same invention" type double patenting rejection is moot. The Applicants, therefore, respectfully request the Examiner withdraw the same. Moreover, the Applicants request the Examiner also reconsider the pending "obviousness type" double patenting rejection in view of this new claim set.

2. The Rejections Raised Under 35 U.S.C. 112, Second Paragraph, Are Moot

The Applicants note the terminal step of the methods recited in each of the pending independent claims is incorporated into the preamble of these same claims. The Applicants submit, therefore, the pending claims particularly point out and distinctly claim the subject matter which the Applicants regard as their invention and, respectfully request the Examiner withdraw this rejection.

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[1] Specification as filed at p. 17, ll. 15-22.
[2] *Id.* at p. 37, ll. 5-12. Also, see Figures 14 and 15. Please note the PDE3 assays documented in the instant application used PDE3 isolated from platelets, a component of blood. *See*, pp. 35-36.
[3] *Id.* at p. 37, ll. 13-23. Also, see Figures 16 and 17. Please note the PDE2 and PDE3 assays documented in the instant application used PDEs isolated from platelets, a component of blood while the PDE1 assay used PDE1 isolated from heart tissue. *See*, pp. 35-36.

CONCLUSIONS

The Applicants respectfully submit the pending claims are in condition for allowance. Should the Examiner believe a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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Thomas W. Brown
Registration No. 50,002

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
617.984.0616